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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/291,426 04/13/99 JAMES

K P-22577GUSA

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EXAMINER

HSU, G

ART UNIT	PAPER NUMBER
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1627

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/291,426	4/13/99	James et al.	P 22,577-G USA

EXAMINER	
HSU, G.	
ART UNIT	PAPER NUMBER
1627	8

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

1. The reply filed on May 11, 2000 is not fully responsive to the prior Office action, because of the following omission(s) or matter(s):

**[A] The reply did fully comply with the request of paragraph section 14 of the February 16, 2000**

**Restriction Requirement. See 37 CFR 1.111.**

- [1] In particular, the following section of paragraph 14 (see, page 7 of the February 16, 2000 Office Action) is reiterated below and followed by further clarification for applicants' convenience:

**For search purposes, applicants should provide the chemical structure of the elected species, wherein the specific chemical formula substituents of that elected species are defined either by picture or by expressing the species in terms of the variables of the formula.**

- [2] For the record, it is noted that, applicants elected a compound having the structure depicted in claim 21, wherein for:

(CH<sub>2</sub>)<sub>b</sub>, b is one;  
R<sub>1</sub> is (CH<sub>2</sub>)<sub>a</sub>, a is two;  
R<sub>2</sub> are straight chained alkyl groups having up to 18 carbon atoms, wherein such straight chain alkyl groups are hexyl groups

- [3] However, the identification of the foregoing substitutions on the first monomer species, as indicated by the chemical structure of claim 21, does not indicate: [a] the relative positions of those substituents on each respective aromatic benzene ring; and [b] relative to each other in an examination of the monomeric species as a whole.

- [4] For this response to be complete, applicants must identify the ~~old~~ positions on each of the two respective aromatic benzene rings (i.e., including their positions relative to all other substituent groups therein and whether any two substituents are ortho, para, meta to each other), the following substituents pictorially indicated as attached to those rings according to the chemical structure of claim 21:

each of the two hydroxy groups each attached to one such ring; the R<sub>1</sub> linking moiety (on the left side of that first monomeric structure); and the (CH<sub>2</sub>)<sub>b</sub> moiety (located on the right side of the first monomeric structure).

2. Upon further consideration, the following species elections now are required:

[B] Applicants are requested for claims 1-27 to:

- [5] elect a species as indicated in step (b), respectively, of both independent claims 1 and 10 and all corresponding dependent claims, of the second and/or third, etc. monomeric species identified therein as "one additional series . . . of different monomers."

- [6] For search purposes, applicants should provide the chemical structure of the elected species, wherein the specific chemical formula substituents of that elected species are defined either by picture or by expressing the species in terms of the variables of the formula.

For this response to be complete, such an identification of the foregoing substitutions on each second and/or third, etc. monomer species, should indicate:  
[a] the relative positions of those substituents on each respective aromatic benzene ring;  
[b] relative to each other in an examination of the monomeric species as a whole; and  
[c] identify the fixed positions, if any, of all substituents in such a species as attached to aromatic benzene rings (i.e., including their positions relative to all other substituent groups therein and whether any two substituents are ortho, para, meta to each other) and/or any other functional groups.

3. This application contains claims directed to the following patentably distinct species of the claimed invention.

4. If applicants elect the invention of **Group I**, applicants are required to further elect from the following

patentably distinct **Species A' and B'** of the claimed invention:

<u>Species A'</u>	<u>claim no.</u>	<u>The copolymer array of claim 10, wherein said polymerizable functional groups of said first monomer series are :</u>
(1)	claim 18	amine groups
(2)	claim 18	hydroxyl groups
<u>Species B'</u>	<u>claim no.</u>	<u>The copolymer array of claim 10, wherein said polymerizable functional groups of said additional series of monomers are selected from the group consisting of :</u>
(3)	claim 18	carboxylic acids (also as applied to claims 20 and 23)
(4)	claim 18	esters
(5)	claim 18	anhydrides
(6)	claim 18	isocyanates

Each of the species identified above represents patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

**For search purposes, applicants should provide the chemical structure of the elected species, wherein the specific chemical formula substituents of that elected species are defined either by picture or by expressing the species in terms of the variables of the formula.**

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 10 is generic.

5. If applicants elect the invention of **Group I**, applicants are required to further elect from the following patentably distinct **Species B' and C'** of the claimed invention:

<u>Species B'</u>	<u>claim no.</u>	The copolymer array of claim 18, wherein said additional series of monomers comprise second and third monomer series, <b>said second monomer series is selected from the group consisting of :</b>
(7)	claim 19	carboxylic acids
(8)	claim 19	esters
(9)	claim 19	anhydrides
(10)	claim 19	isocyanates

  

<u>Species C'</u>	<u>claim no.</u>	The copolymer array of claim 18, wherein said additional series of monomers comprise second and third monomer series, <b>said third monomer series comprises a plurality of alkylene oxides selected from the group consisting of :</b>
(11)	claim 19	ethylene oxide
(12)	claim 19	propylene oxide
(13)	claim 19	isopropylene oxide
(14)	claim 19	butylene oxide
(15)	claim 19	isobutylene oxide
(16)	claim 19	"random, block and co-polymers thereof (if applicants elect this species, which of the above species forms the species of this grouping must be identified)."

Each of the species identified above represents patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

**For search purposes, applicants should provide the chemical structure of the elected species, wherein the specific chemical formula substituents of that elected species are defined either by picture or by expressing**

**the species in terms of the variables of the formula.**

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 10 is generic.

6. If applicants elect the invention of **Group I**, applicants are required to further elect from the following patentably distinct **Species D'** of the claimed invention:

<b><u>Species D'</u></b>	<b><u>claim no.</u></b>	<b><u>The copolymer array of claim 10, wherein said copolymers are further modified by:</u></b>
(8)	claim 27	chemical reaction
(9)	claim 28	cross linking

Each of the species identified above represents patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

**For search purposes, applicants should provide the specific chemical reactions and/or to what the aforementioned co-polymer array is “crosslinked with” of the respective elected species, wherein the specific chemical reactions of that elected species are defined either by picture or by expressing the species in terms of the variables of the formula(s) of all reactants, including chemical formula structures with substituents.**

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 10 is generic.

7. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

### *Conclusion*

12. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 5:30 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jythosna Venkat, may be reached at (703) 308-2439. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

BENNETT CELSA  
PRIMARY EXAMINER  
*M. Bennett Celsa*

8/6/01